I. INTRODUCTION

In response to the Office Action dated November 28, 2006, claim 1 has been amended. Claims 1, 3, 5-11, 13, 15, 17, 19-25, 27, 29, 31, 41, 43, 45, 47, 49, 51, 53, and 61-66 remain in the application. Entry of these amendments, and re-consideration of the application, as amended, is requested.

II. CLAIM AMENDMENTS

Applicant's attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. NON ART REJECTION

In paragraphs (1)-(2) of the Office Action, claims 1, 3, and 5-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicants have amended claim 1 to provide proper antecedent basis and submit that the rejection is now moot.

IV. SUMMARY OF THE INVENTION

Independent claims 1, 11, 15, 25, 29, and 39 are generally directed to an invention that enables cellular phone instant messaging (see page 2, lines 11-12). The amended independent claims provide for a telemetry message that is in the form of a remote feature activation message (see page 7, lines 5-7 and page 8, line 9-page 9, line 4). In addition, the telemetry message comprises an indication that the cellular phone has been powered on (see page 7, lines 7-9 and 12-20). The remote feature activation message is transmitted from the cellular phone to a foreign cellular network 9see page 7, lines 9-11; page 8, line 10-page 9, line 14; FIG. 2, step 802).

As amended, the claims provide for a specific set of steps wherein the telemetry message is transmitted from the cellular phone to a foreign cellular network to a home cellular network (see page 8, line 10-page 9, line 14). Further, remote feature activation messages are specific types of

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messages (see page 8, line 10-page 9, line 4). The specific types/forms of remote feature activation messages are also specifically claimed limitations for the independent claims. In this regard, the remote feature activation message is interpreted by the foreign cellular network as a roaming cellular phone desiring to activate/deactivate a feature (see page 8, lines 10-20). As a result, the foreign cellular network forwards the message to the phone's home cellular network (see page 8, lines 16-20). Further, instead of activating/deactivating a feature, the message is used to store information (e.g., a buddy list) regarding the cellular phone in an instant messaging database (see FIG. 2, step 206) transmitting a browser alert to buddies in the buddy list (see page 9, lines 5-14; page 10, lines 5-17; FIG. 2, steps 208-212). Thus, the cellular network enables the instant messaging by interpreting the telemetry message as a remote feature activation message. In this regard, rather than using the telemetry message to activate a feature, the message is used for an entirely different purpose – merely to indicate availability on a network.

In addition, dependent claims 61-66 provide for utilizing a second telemetry message that comprises the standard registration message that a cellular phone forwards to a foreign cellular network prior to being able to place or make any phone calls (see page 7, lines 12-20).

Additional dependent claims set forth limitations regarding the telemetry message including that the message may be data encoded in a dialed digits field of a message (see page 9, lines 10-12). As described in the specification at page 8, lines 10-15, such a message may be in the form of a fictitious area code preceded by the star character (*). The message is interpreted by the cellular network as identifying a roaming cellular phone that desires to activate/deactivate a feature (e.g., call forwarding, call waiting, etc.) (see page 8, lines 15-16). Accordingly, the message is transmitted to the cellular phone's home cellular network (see page 8, lines 16-20). The home cellular network interprets the message as being available on a cellular network for purposes of instant messaging. Thus, the remote feature activation message for use in instant messaging is handled by the foreign cellular network similar to standard remote feature activation messages. Yet the remote feature activation of the present invention enables cellular instant messaging.

In view of the above, Applicants note that a significant advantage of the present invention that is set forth in the claims is the use of the remote feature activation message to enable the cellular instant messaging. In this regard, in response to the receipt of the remote feature activation message (as part of the telemetry message), information for instant messaging is stored in a database

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and used to transmit information to buddies in a instant messaging buddy list. The unique ability to use remote feature activation messages to enable instant messaging is not even remotely disclosed in any of the cited references.

V.   PRIOR ART REJECTIONS

In paragraphs (3)-(4) of the Office Action, claims 1, 3-11, 13, 15, 17, 19-25, 27, 29, 31, 33-39, 41, 43, 45, 47, 49, 51, 53, and 61-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Adamany et al., U.S. Publication No. 2002/0173306 (Adamany) in view of Aravamudan et al., U.S. Patent No. 6,301,609 (Aravamudan).

Specifically, the independent claims were rejected as follows:

> Regarding claim 1 Adamany et al teaches a method for enabling cellular instant messaging comprising (figs. 1-2):
> Receiving, in a cellular phone's home cellular network (12), telemetry message (registration message) from a foreign cellular network (14) (para # 0038):
> the telemetry message was originally transmitted from a first cellular phone to the foreign cellular network (para # 0034, 0038);
> the telemetry comprises an indication that the first cellular phone has been power on (para # 0038, 42-43); and
> the telemetry message comprises a remote feature activation message is interpreted by the foreign cellular network as a roaming cellular phone desiring to activate/deactivate a feature (para #0038, 42-43);
> in response to the home cellular network receiving the telemetry message, storing information regarding the first cellular phone in an instant messaging database (HLR 16), wherein the information comprises a list (para # 0038, 42-43). Adamany et al does not specifically teach transmitting a browser alert to one or more relevant buddies identified in the buddy list.
> In an analogous art, Aravamudan et al teaches transmitting a browser alert to one or more relevant buddies identified in the buddy list (col.7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25). Aravamudan et al teaches the CPE device that a user is utilizing is a packet device, then the packet address to which the CPE device is attached is provided. The IM server then notifies the CSP of the user's online presence and address. The IM server also notifies selected buddies to the user of the users presence online. The CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached and notification received, the CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached and held in abeyance during that time period for which the user had been off-line or inactive. The user's real presence is therefore advertised to others who have identified the user as a buddy. However, when the user is off-line, all others who have identified the user as a buddy are notified that the user is not online and is not available. Therefore, it would have been obvious to one or ordinary skill in the art at the time the invention was made to modify the device of Adamany et al by specifically adding transmitting a browser alert to one or more relevant buddies identified in the buddy list feature in order to enhance system performance to user can maintain control his online presence and activities, enabling the associate with directly interface with the user when the user is online as taught by Aravamudan et al.

> Regarding claim 11 Adamany et al teaches a method for enabling cellular instant messaging comprising (figs. 1-5):

transmitting, from a first cellular phone to foreign cellular network, a telemetry message (para # 0038, 42-43), wherein:

the telemetry message comprises an indication that the first cellular phone has been powered on (para # 0038, 42-43); and

the telemetry message comprises a remote feature activation message wherein the remote feature activation message is interpreted by the cellular network as a roaming cellular phone desiring to activate/deactivate a feature, and wherein the foreign cellular network forwards the telemetry message to the cellular phone's cellular network (para # 0038, 42-43). Adamany et al does not specifically teach receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone.

In an analogous art, Aravamudan et al teaches receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25). Aravamudan et al teaches the CPE device that a user is utilizing is a packet device, then the packet address to which the CPE device is attached is provided. The IM server then notifies the CSP of the user's online presence and address. The IM server also notifies selected buddies to the user of the users presence online. The CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached and notification received, the CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached and held in abeyance during that time period for which the user had been off-line or inactive. The user's real presence is therefore advertised to others who have identified the user as a buddy. However, when the user is off-line, all others who have identified the user as a buddy are notified that the user is not online and is not available. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Adamany et al by specifically adding transmitting a browser alert to one or more relevant buddies identified in the buddy list feature in order to enhance system performance to user can maintain control his online presence and activities, enabling the associate with directly interface with the user when the user is online as taught by Aravamudan et al.

Regarding claim15 Adamany et al teaches a system for enabling cellular instant messaging comprising (figs. 1-5):

a home cellular network (14); a home cellular network (12);

and

a server on the cellular network, configured to:

receive a telemetry message comprising a remote feature activation message from the foreign cellular network, wherein the telemetry message was originally transmitted from the first cellular phone wherein telemetry message indicates that the first cellular phone has been powered on and wherein the remote feature activation message is interpreted by the cellular network as a roaming cellular phone desiring to activate/deactivate a feature (para # 0038, 42-43). Adamany et al does not specifically teach transmit a browser alert to one or more relevant buddies identifies in the buddy list.

In an analogous art, Aravamudan et al teaches transmit a browser alert to one or more relevant buddies identified in the buddy list (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25). Aravamudan et al teaches the CPE device that a user is utilizing is a packet device, then the packet address to which the CPE device is attached is provided. The IM server then notifies the CSP of the user's online presence and address. The IM server also notifies selected buddies to the user of the users presence online. The CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached and notification received, the CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network and the address to which the CPE device is attached and held in abeyance during that time period for which the user had been off-line or inactive. The user's real presence is therefore advertised to others who have identified the user as a buddy. However, when the user is off-line, all others who have identified the user as a buddy are notified that the user is not online and is not available. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Adamany et al by specifically adding transmitting a browser alert to one or more relevant buddies

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identified in the buddy list feature in order to enhance system performance to user can maintain control his online presence and activities, enabling the associate with directly interface with the user when the user is online as taught by Aravamudan et al.

As to claim 25 it is considered the claim is rejected for the same reason as set forth in claim 1.

As to claim 29 it is considered the claim is rejected for the same reason as set forth in claim 11.

As to claim 39 it is considered the claim is rejected for the same reason as set forth in claim 15.

Applicant traverses the above rejections for one or more of the following reasons:

(1)   Neither Adamany nor Aravamudan teach, disclose or suggest using a remote feature activation message to initiate or utilize an instant messaging system, or as part of an instant messaging system;

(2)   Neither Adamany nor Aravamudan teach, disclose or suggest a remote feature activation message sent by a cellular phone that is interpreted by a cellular network as a roaming phone desiring to activate/deactivate a feature, which is used to store information utilized in an instant messaging application; and

(3)   Neither Adamany nor Aravamudan teach, disclose or suggest a remote feature activation message that indicates that a cellular phone has been powered on.

The Office Action initially relies on Adamany to teach the telemetry message comprising a remote feature activation message that is interpreted by the foreign cellular network as a roaming cellular phone desiring to activate/deactivate a feature while relying on paragraph 34 and 38.

Paragraph 34 provides:

> [0034] FIG. 1 also illustrates a visited system 14 including a wireless unit 20 that is roaming or visiting in the visited system 14. When the wireless unit 20 is turned on, typically it provides registration information to a base station 22 serving the cell of the visiting system wherein the wireless unit 20 is roaming. The registration information typically includes the mobile identification number (MIN) for the wireless unit 20. The base station 22 generally provides the registration information to a mobile switching center (MSC-V) 24.

Paragraph 38 provides:

> [0038] Assume a subscriber travels from country A to country B and as a roamer desires to use his or her wireless unit for communications between the two countries. Referring to FIG. 2, after start 50, in block 52, the roamer powers-on or turns on his or her wireless unit 20 and generally begins the registration of the wireless unit 20 with a serving MSC (MSC-V) 24 in a visited system 14 of country B. In block 54, the MSC-V 24 receives the registration information that is provided by the wireless unit 20, which information typically includes the ESN and MIN of the wireless unit 20. In response to receiving the registration information, the MSC-V 24 generally analyzes the information to the extent the MSC-V 24 determines that the wireless unit 20 is a roaming unit and that the wireless unit 20 is

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not listed in its visitor's location register (VLR) 26. Also, the MSC-V 24 may consult a roamer access table (RAT) 28. In consulting the RAT, the MSC-V 24 may find an entry 30 in the RAT for the MIN of the wireless unit. The entry 30 may provide the MSC-V 24 with an association between the MIN for the wireless unit 20 and a point code for the international gateway 10. The information relating to the association between the wireless unit's information and the point code of the international gateway 10 generally results from a relationship established and based on the roamer's subscription for wireless service from a service provider that is a customer or otherwise affiliated with the international gateway 10 or provider of international gateway services. Thus, the RAT table 28 in the MSC-V 24 may be set up with the point code of the international gateway 10 associated with the visiting subscriber's MIN range in the VLR 26 of the MSC-V 24.

As can be seen, paragraph 34 merely describes that when a unit is turned on, registration information is provided to a base station which in turn provides the registration information to a mobile switching center.

Paragraph 38 provides that when a roaming phone turns on the phone, the phone is registered with a serving mobile switching center. The MSC determines that it is a roaming phone and consults a roamer access table for a connection between the phone and an international gateway.

Thus, as can be clearly seen from the above paragraphs and the remainder of Adamany, Adamany merely describes the standard use and registration of a roaming phone in a foreign network. Such a teaching is not even remotely similar to that used and claimed in the present invention. In the present invention, rather than the power on merely sending the standard registration message (as in Adamany), the power on of the phone is processed as a remote feature activation message. Since it appears as a remote feature activation message, the foreign network merely forwards it to the home network which then uses the message to establish instant messaging (i.e., by storing information in an instant messaging database, using a buddy list, and transmitting a browser alert to a buddy identified in the buddy list). In addition, Applicants note that the standard registration message may also be transmitted (as set forth in dependent claims 61-66 and described in further detail below).

Again, Adamany merely describes the standard roaming cellular phone functionality. What is different about the present invention is the use of such information that appears as a remote feature activation message but is actually used to establish instant messaging.

The Action attempts to combine Adamany with Aravamudan stating that Aravamudan teaches the transmission of a browser alert to relevant buddies identified in the buddy list.

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Applicants submit that not only is there a complete failure of any showing of a motivation to combine, but even if the two references were combined, the present invention would not result.

Aravamudan merely describes a unified messaging solution and services platform that utilizes the features and capabilities associated with instant messaging to locate a registered user, query the user for a proposed message disposition, and coordinate services among a plurality of communication devices, modes, and channels. A user proxy is registered to the user as a personal communication services platform. The user is able to define various rules for responding to received data and communications, the rules stored within a rules database servicing the communication services platform. Instant messaging is used for communications between the user and the communication services platform's user proxy (see Abstract).

However, as admitted in the prior Office Actions, Aravamudan fails to teach the interpretation of the remote feature activation message as a roaming cellular phone desiring to activate/deactivate a feature. In addition, as described above, there is no teaching of the unusual and unique use and combination of the remote feature activation message in a instant messaging context (as claimed).

Applicants note that it is the combination of the elements of the invention that contribute to the unique and nonobvious nature of the invention. In this regard, none of the cited prior art has even remotely considered using a remote feature activation message to act in a manner out of the standard use. More specifically, none of the cited prior art has described, considered, or suggested the use of a remote feature activation message that is used so that the message is forwarded to a home cellular network where it is interpreted and used to enable instant messaging. In this regard, the Office Action is combining the two references without any consideration of why or how the services would work together.

The motivation provided in the Office Action is:

> The user's real presence is therefore advertised to others who have identified the user as a buddy. However, when the user is off-line, all others who have identified the user as a buddy are notified that the user is not online and is not available. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Adamany et al by specifically adding transmitting a browser alert to one or more relevant buddies identified in the buddy list feature in order to enhance system performance to user can maintain control his online presence and activities, enabling the associate with directly interface with the user when the user is online as taught by Aravamudan et al.

However, Applicants note that such a motivation is illogical and lacks sufficient basis on its face. In this regard, Adamany does not relate to instant messaging whatsoever nor does it describe the use of a remote feature activation message for anything other than the standard use. Further, since Adamany does not relate to nor describe or remotely allude to instant messaging, there would be no need or desire to add a browser alert to the system of Adamany.

Further, since Adamany fails to teach the use of a remote feature activation message for anything other than the standard use, even if Adamany were combined with Aravamudan, the result would not be use claimed use of the remote feature activation message to enable instant messaging.

Applicants also direct the attention of the Examiner to the dependent claims – specifically, dependent claims 61-66. These dependent claims provide for sending an additional second message for the registration of the cellular phone on a foreign network. Thus, two separate messages are sent. Sakai completely fails to describe any such use of multiple messages. Further, the use of such a dependent claim illustrates that the power on message is not the standard message that is transmitted but is part of the instant messaging system that is enabled by the invention. Thus, such dependent claims further differentiate the present invention from the cited references. In rejecting claims 61-66, the Office Action merely relies on paragraphs 38 and 42-43 of Adamany. However, these paragraphs completely and entirely fail to teach, describe, or remotely allude to the use of two messages. Instead, such paragraphs (and the remainder of Adamany) merely describe the single registration message that transmitted at the time of powerup. Consequently, Adamany cannot and does not teach the two separate messages that are set forth in both the dependent and independent claims. Without teaching the two messages, the combination cannot possibly teach or render the claimed invention obvious.

In view of the above, Applicants submit that the various elements of Applicant's claimed invention together provide operational advantages over the systems disclosed in Adamany and Aravamudan. In addition, Applicant's invention solves problems not recognized by Adamany and Aravamudan.

Thus, Applicant submits that independent claims 1, 11, 15, 25, 29, and 39 are allowable over Adamany and Aravamudan. Further, dependent claims 3, 5-10, 13, 17, 19-24, 27, 31, 33-38, 41, 43, 45, 47, 49, 51, 53, and 61-66 are submitted to be allowable over Adamany and Aravamudan in the same manner, because they are dependent on independent claims 1, 11, 15, 25, 29, and 39,

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respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 3, 5-10, 13, 17, 19-24, 27, 31, 33-38, 41, 43, 45, 47, 49, 51, 53, and 61-66 recite additional novel elements not shown by Adamany and Aravamudan.

VI.   CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

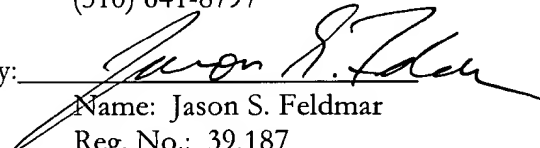Respectfully submitted,

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